

REMARKS

- Claims **50 – 77** are currently pending.
- Of the pending claims, only claims **50, 71, 72 and 74** are independent.
- All of the pending claims stand rejected.
- Each of the independent claims **50, 71, 72 and 74** has been amended herein.

1. Terminal Disclaimer and Double Patenting

Applicants have filed a terminal disclaimer herein, signed by Magdalena M. Fincham, as a substitute for the terminal disclaimer previously submitted and not accepted. As suggested by the Examiner, Applicants have also filed a power of attorney for this application, the power of attorney naming Magdalena M. Fincham. Applicants thus respectfully request that the terminal disclaimer be accepted.

2. Claim Rejection - Section 102

Claims **50 – 54, 56 – 58, 60 – 62, 64 – 69 and 71 – 77** stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,833,537 to Barrie ("Barrie" herein).

Independent Claims 50, 71 and 74

Each of Independent claims **50, 71 and 74** has been amended to claim a particular embodiment and to include the following set of limitations that is not taught or suggested by Barrie.

- *determining a number of occurrences of the at least one tracked symbol;*
- *determining whether the number is at least a minimum number; and*
- *providing, if the number is at least a minimum number, a bonus payout*

In other words, in accordance with an embodiment, a player may “collect” occurrences of a symbol (e.g., over a plurality of outcomes) and receive a payout once the number of symbols collected is at least a minimum number. For example, a player may collect “lemon” symbols and, once the player collects twenty (20) lemons, the player may be provided with a bonus payout. Barrie does not teach or suggest any collection of symbols, much less providing a payout if a minimum number of symbols are collected. At most, Barrie teaches that a particular type of symbol may affect a payout, by affecting a magnitude of a multiplier applied to the payout.

For example, with respect to Fig. 4, Barrie describes that a multiplier symbol, if it occurs on a payline, changes the multiplier associated with the payline: “when [a multiplier symbol occurs in a symbol position of a payline] the multiplier in the payline which contains this position 118h (in this example, the bottom payline 412c[sic] is changed to show a new value. In one embodiment, the new value will be the sum of the previous value and the value of the multiplier symbol.” Col. 6, lines 5 – 10. However, there is no teaching or disclosure in Barrie that the occurrence of such a multiplier symbol in any manner causes a bonus payout to be provided, much less the particular embodiment of determining whether to provide a bonus payout claimed in claims **50, 71 and 74** (if the number of occurrences of a tracked symbol is at least a minimum number).

In Barrie, even though a multiplier symbol occurred, no payout is provided based on the occurrence of this symbol, unless and until a winning outcome is achieved on the payline associated with the symbol. In fact, Barrie explicitly teaches away from providing any payout based solely on the occurrence (or number of occurrences) of a multiplier or other persistence symbol:

“Preferably, the symbols can affect the amount of a pay out, although preferable they do not affect whether or not a game has a winning result.” Col. 2, lines 27 – 29; and

“persistence symbols are believed to add to the action or play of the game, but do not, in themselves, occasion a pay out.” Col. 9, lines 1 – 2.

Thus, even if some number of multiplier or other persistence symbols were to be obtained by the player in Barrie, the mere occurrence of these symbols do not occasion a payout, as is claimed in claims **50, 71 and 74**. Rather, the occurrence of a multiplier or other persistence symbol in Barrie may merely “affects the amount of the price or award, for at least some winning game outcomes.” Col. 2, lines 13 – 15. In Applicants’ claimed embodiments, once a minimum number of occurrences of at least one tracked symbol is determined, a bonus payout is provided.

Independent Claim 72

Applicants respectfully submit that independent claim **72** is patentable over Barrie for reasons similar to those discussed with respect to independent claims **50, 71 and 74**. Specifically, independent claim **72** recites the following feature that is not taught or suggested by Barrie:

- *determining a count value wherein the count value is incremented when there is an occurrence of the at least one tracked symbol and the count value is decremented when an occurrence of the at least one tracked symbol expires, such that the count value may be a non-zero integer after the count value is decremented upon an expiration of an occurrence; and*
- *providing a bonus payout when the count value exceeds the bonus value*

In other words, similarly to the embodiment discussed with respect to independent claims **50, 71 and 74**, once a number of collected symbols exceeds a certain number (referred to as a bonus value), a bonus payout is provided. There is no such teaching or suggestion in *Barrie*, as discussed above. Rather, *Barrie* is limited to affecting a magnitude of a payout to be provided based on an independent occasion of a winning game outcome being obtained by a player.

It is respectfully submitted that each of dependent claims **51 – 54, 56 – 58, 60 – 62, 64 – 69 and 73, and 75 – 77** is patentable at least for the same reasons as claims 50, 71, 72 and 74 (i.e., because each of these independent claims include one of the sets of features discussed above).

3. Claim Rejections - Section 103

Claims **55, 59 and 63** stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Barrie* in view of U.S. Patent No. 6,165,071 to *Weiss*. Claim **70** stands rejected under 35 U.S.C. §103(a) over *Barrie*. Applicants respectfully traverse these rejections because *Weiss*, like *Barrie*, fails to teach or suggest the

feature of providing a bonus payout if it is determined that a number of occurrences of a tracked symbol is at least equal to (or exceeds) a minimum number or bonus value.

Further, no proper motivation to modify the reference has been provided. The stated motivations are merely statements of asserted advantages that may be realized from the proposed motivations. The motivations do not appear as objective teachings in the record that would have motivated one of ordinary skill in the art to make the proposed modifications, as is required.

C O N C L U S I O N

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham at telephone number (203) 461-7041 or via electronic mail at mfincham@walkerdigital.com.